

GIAN 2764

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/222,336
Filing Date	December 28, 1998
First Named Inventor	Guy A. Story, Jr.
Group Art Unit	2764
Examiner Name	C. Lee
Attorney Docket Number	002541.P009

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FEB 22 2000

GROUP 2700

Total Number of Pages in This Submission ~~45~~ 27

ENCLOSURES (check all that apply)

☒ Fee Transmittal Form

☐ Fee Attached

☒ Amendment / Response

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/Incomplete Application

☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

☐ Assignment Papers (for an Application)

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition Routing Slip (PTO/SB/69) and Accompanying Petition

☐ To Convert a Provisional Application

☐ Power of Attorney, Revocation Change of Correspondence Address

☐ Terminal Disclaimer

☐ Small Entity Statement

☐ Request for Refund

☐ After Allowance Communication to Group

☐ Appeal Communication to Board of Appeals and Interferences

☐ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Additional Enclosure(s) (please identify below):

Resubmission of Amendment

copy of original amendment and related paperwork.

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name

Paul A. Mendonsa, Reg. No. 42,879

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Signature

Paul A. Mendonsa

Date

February 7, 2000

CERTIFICATE OF MAILING/TRANSMISSION

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PTO/SB/17 (6/99)

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Approved for use through 09/30/2000. OMB 0651-0032

FEE TRANSMITTAL for FY 1999

Patent fees are subject to annual revision.
Small Entity payments must be supported by a small entity statement,
otherwise large entity fees must be paid. See Forms PTO/SB/09-12.
See 37 C.F.R. §§ 1.27 and 1.28.

TOTAL AMOUNT OF PAYMENT (\$)

0.00

Complete if Known

Application Number 09/222,336
Filing Date December 28, 1998
First Named Inventor Guy A. Story, Jr.
Examiner Name C. Lee
Group/Art Unit 2764
Attorney Docket Number 002541.P009

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METHOD OF PAYMENT (check one)

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

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Blakely, Sokoloff, Taylor & Zafman LLP

- ☒ Charge Any Additional Fees Required Under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.

2. ☒ Payment Enclosed:

☒ Check ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Small Entity Fee Code	Fee (\$)	Fee (\$)	Fee Description	Fee Paid
101	201	690	345	Utility filing fee	
106	206	310	155	Design filing fee	
107	207	480	240	Plant filing fee	
108	208	690	345	Reissue filing fee	
114	214	150	75	Provisional filing fee	

SUBTOTAL (1)

(\$)

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
28	28	18.00	0
4	4	78.00	

Multiple Dependent

**or number previously paid, if greater, For Reissues, see below

Large Entity Fee Code	Small Entity Fee Code	Fee (\$)	Fee (\$)	Fee Description
103	203	18	9	Claims in excess of 20
102	202	78	39	Independent claims in excess of 3
104	204	260	130	Multiple Dependent claim, if not paid
109	209	78	39	**Reissue independent claims over original patent
110	210	18	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$)

0.00

FEE CALCULATION (continued)

3. ADDITIONAL FEE

Large Entity Fee Code	Small Entity Fee Code	Fee (\$)	Fee (\$)	Fee Description	Fee Paid
105	205	130	65	Surcharge - late filing fee or oath	
127	227	50	25	Surcharge - late provisional filing fee or cover sheet.	
139	239	130	130	Non-English specification	
147	247	2,520	2,520	For filing a request for reexamination	
112	212	920*	920*	Requesting publication of SIR prior to Examiner action	
113	213	1,840*	1,840*	Requesting publication of SIR after Examiner action	
115	215	110	55	Extension for response within first month	
116	216	380	190	Extension for response within second month	
117	217	870	435	Extension for response within third month	
118	218	1,210	680	Extension for response within fourth month	
128	228	1,850	925	Extension for response within fifth month	
119	219	300	150	Notice of Appeal	
120	220	300	150	Filing a brief in support of an appeal	
121	221	260	130	Request for oral hearing	
138	238	1,510	1,510	Petition to institute a public use proceeding	
140	240	110	55	Petition to revive - unavoidable	
141	241	1,210	605	Petition to revive - unintentional	
142	242	1,210	605	Utility issue fee (or reissue)	
143	243	430	215	Design issue fee	
144	244	580	290	Plant issue fee	
122	222	130	130	Petitions to the Commissioner	
123	223	50	50	Petitions related to provisional applications	
126	226	240	240	Submission of Information Disclosure Stmt	
581	281	40	40	Recording each patent assignment per property (times number of properties)	
146	246	790	395	Filing a submission after final rejection (37 CFR 1.129(a))	
149	249	790	395	For each additional invention to be examined (37 CFR 1.129(b))	

Other fee (specify)

Other fee (specify)

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$)

SUBMITTED BY

Typed or
Printed Name

Paul A. Mendonsa

Signature

Paul A. Mendonsa

Date

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42,879

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FILE



09/222,336

Serial/Patent No.: 08/792,651 Filing/Issue Date: December 28, 1998
Client: Audible (Story, et al.)
Title: LICENSE MANAGEMENT FOR DIGITAL CONTENT

BS TZ File No.: 002541.P009 Atty/Secty Initials: JHS/PAM/ndm
Date Mailed: January 14, 2000 Docket Due Date: 1/27/00

The following has been received in the U.S. Patent & Trademark Office on the date stamped hereon:

<input checked="" type="checkbox"/> Amendment/Response (<u>9</u> pgs.)	<input type="checkbox"/> Express Mail No.:	<input checked="" type="checkbox"/> Check No. <u>7484</u>
<input type="checkbox"/> Appeal Brief (<u> </u> pgs.) (in triplicate)	<input type="checkbox"/> Month(s) Extension of Time	Amt: <u>\$150.00</u>
<input type="checkbox"/> Application - Utility (<u> </u> pgs., with cover and abstract)	<input type="checkbox"/> Information Disclosure Statement & PTO 1449 (<u> </u> pgs.)	<input type="checkbox"/> Check No. <u>7484</u>
<input type="checkbox"/> Application - Rule 1.53(b) Continuation (<u> </u> pgs.)	<input type="checkbox"/> Issue Fee Transmittal	Amt: <u> </u>
<input type="checkbox"/> Application - Rule 1.53(b) Divisional (<u> </u> pgs.)	<input type="checkbox"/> Notice of Appeal	
<input type="checkbox"/> Application - Rule 1.53(b) CIP (<u> </u> pgs.)	<input type="checkbox"/> Petition for Extension of Time	
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<input type="checkbox"/> Application - Provisional (<u> </u> pgs.)	<input type="checkbox"/> Preliminary Amendment (<u> </u> pgs.)	
<input type="checkbox"/> Assignment and Cover Sheet	<input type="checkbox"/> Reply Brief (<u> </u> pgs.)	
<input checked="" type="checkbox"/> Certificate of Mailing	<input type="checkbox"/> Response to Notice of Missing Parts	
<input type="checkbox"/> Declaration & POA (<u> </u> pgs.)	<input type="checkbox"/> Small Entity Declaration for Indep. Inventor/Small Business	
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AMOUNT

ACCT. NO.

DATE DESCRIPTION

1/14/2000

U.S. Patent and Trademark Office additional claims
filing fee for LICENSE MANAGEMENT FOR DIGITAL
CONTENT

INVENTOR: STORY, ET AL.

\$ 150.00

9670.1

SERIAL NO.: ~~067792,651~~ 09/200, 336

002541.P009 PAM/ndm

The Audible Words Corp.

17041

07404



Attorney's Docket No.: 002541.P009

Patent

In re the Application of: Story, et al.

Application No.: ~~08/792,651~~ 09/222,336

Filed: December 28, 1998

For: LICENSE MANAGEMENT FOR DIGITAL CONTENT

ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

SIR: Transmitted herewith is an Amendment for the above application.

 Small entity status of this application under 37 C.F.R. §§ 1.9 and 1.27 has been established by a verified statement previously submitted.

 A verified statement to establish small entity status under 37 C.F.R. §§ 1.9 and 1.27 is enclosed.

 No additional fee is required.

The fee has been calculated as shown below:

	(Col. 1) Claims Remaining After Amd.		(Col. 2) Highest No. Previously Paid For	(Col. 3) Present Extra
Total Claims	* 28	Minus	** 24	4
Indep. Claims	* 4	Minus	*** 3	1
First Presentation of Multiple Dependent Claim(s)				

SMALL ENTITY

Rate	Additional Fee
X9	\$
X39	\$
+130	\$
Total Add. Fee	\$

**OTHER THAN A
SMALL ENTITY**

Rate	Additional Fee
X18	\$ 72.00
X78	\$ 78.00
+260	\$
Total Add. Fee	\$ 150.00

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest No. Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space. The "Highest No. Previously Paid For" (Total or Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

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on January 14, 2000

Date of Deposit

Michelle J. Turner

Name of Person Mailing Correspondence

Michelle J. Turner
Signature

1-14-2000
Date

xx A check in the amount of \$ 150.00 is attached for presentation of additional claim(s).
Applicant(s) hereby Petition(s) for an Extension of Time of _____ month(s) pursuant to
37 C.F.R. § 1.136(a).

 A check for \$ _____ is attached for processing fees under 37 C.F.R. § 1.17.

 Please charge my Deposit Account No. 02-2666 the amount of \$ _____.

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X Any additional filing fees required under 37 C.F.R. § 1.16 for presentation of
extra claims.

X Any extension or petition fees under 37 C.F.R. § 1.17.

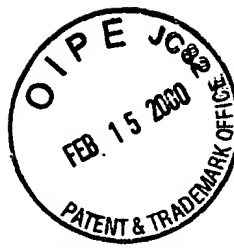
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

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Date: JAN. 14, 2000

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Reg. No. 42,879



Attorney Docket No.: 002541.P009

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Story, et al.

Application No: ~~08/792,651~~ *09/222,336*

Filed: December 28, 1998

For: LICENSE MANAGEMENT FOR DIGITAL
CONTENT

Examiner: C. M. Lee

Art Unit: 2764

Assistant Commissioner For Patents
Washington, D.C. 20231

January 14, 2000
MICHELLE J. TURNER
[Signature] *1-14-2000*

AMENDMENT

Dear Sir:

In response to the Office Action mailed October 27, 1999, please enter this amendment and consider the following remarks.

IN THE CLAIMS

- 1 1. (Amended) A method of managing digital content licenses, the method
- 2 comprising:
- 3 creating a first license having a first cardinality, the license created by a license
- 4 management device;
- 5 storing the first license in a first set of playback devices in response to a command
- 6 from the license management device, wherein the first set of playback devices is
- 7 determined based, at least in part, on the first cardinality;
- 8 storing the first license in first digital audio content; and

9 authorizing playback of the first digital audio content with the first set of playback
10 devices.

1 2. (Amended) The method of claim 1 further comprising:
2 storing the first license in second digital audio content; and
3 authorizing playback of the second digital audio content with the first set of
4 playback devices.

1 3. (Amended) The method of claim 1 further comprising:
2 creating a second license having a second cardinality, the license created by the
3 license management device;
4 storing the second license in a second set of playback devices, wherein the second
5 set of playback devices is determined based, at least in part, on the second cardinality, and
6 further wherein at least one playback device belongs to the first set and to the second set;
7 storing the second license in second digital audio content;
8 authorizing playback of the second digital audio content with the second set of
9 playback devices.

1 7. (Amended) The method of claim 1 wherein at least one of the first set of
2 playback devices comprises at least one [is a] hardware playback device.

1 8. (Amended) The method of claim 1 wherein at least one of the first set of
2 playback devices comprises at least one [is a] software player.

Please cancel claim 9 without prejudice.

1 10. (Amended) The method of claim 1 wherein the first digital audio content
2 further comprises [is audio/visual] video digital programming.

1 11. (Amended) A machine-readable medium having stored thereon sequences
2 of instructions that when executed by one or more processors cause [the] one or more
3 electronic systems [processors] to:
4 create a first license with a license management device, the first license having a
5 first cardinality;
6 store the first license in a first set of playback devices in response to a command
7 from the license management device, wherein the first set of playback devices is
8 determined based, at least in part, on the first cardinality;
9 store the first license in first digital audio content; and
10 authorize playback of the first digital audio content with the first set of playback
11 devices.

1 12. (Amended) The machine-readable medium of claim 11 further comprising
2 sequences of instructions that when executed cause the one or more electronic systems
3 [processors] to:
4 store the first license in second digital audio content; and

5 authorize playback of the second digital audio content with the first set of
6 playback devices.

1 13. (Amended) The machine-readable medium of claim 11 further comprising
2 sequences of instructions that when executed cause the one or more electronic systems
3 [processors] to:

4 create a second license in the license management device, the second license
5 having a second cardinality;

6 store the second license in a second set of playback devices, wherein the second
7 set of playback devices is determined based, at least in part, on the second cardinality, and
8 further wherein at least one playback device belongs to the first set and to the second set;

9 store the second license in second digital audio content;

10 authorize playback of the second digital audio content with the second set of
11 playback devices.

1 17. (Amended) The machine-readable medium of claim 11 wherein at least
2 one of the first set of playback devices comprises at least one [is a] hardware playback
3 device.

1 18. (Amended) The machine-readable medium of claim 11 wherein at least
2 one of the first set of playback devices comprises at least one [is a] software player.

Please cancel claim 19 without prejudice.

1 20. (Amended) The machine-readable medium of claim 11 wherein the first
2 digital audio content further comprises [is audio/visual] digital video programming.

1 21. (Amended) An apparatus for digital license management, the apparatus
2 comprising:
3 means for creating a first license in a license management device, the first license
4 having a first cardinality;
5 means for storing the first license in a first set of playback devices in response to a
6 command from the license management device;
7 means for storing the first license in first digital audio content; and
8 means for authorizing playback of the first digital audio content with the first set
9 of playback devices.

1 22. (Amended) The apparatus of claim 21 further comprising:
2 means for storing the first license in second digital audio content; and
3 means for authorizing playback of the second digital audio content with the first
4 set of playback devices.

1 23. (Amended) The apparatus of claim 21 further comprising:
2 means for creating a second license in the license management device;

3 means for storing the second license in a second set of playback devices, wherein
4 at least one playback device from the second set of playback devices is included in the
5 first set of playback devices;
6 means for storing the second license in second digital audio content; and
7 means for authorizing playback of the second digital audio content with the
8 second set of playback devices.

Please add the following new claims:

1 24. (New) A digital data signal embodied in a data communications medium
2 shared among a plurality of network devices to provide digital audio programming, the
3 digital data signal comprising license having a first cardinality, the license having been
4 created by a license management device, the digital data signal further comprising a first
5 digital audio content that is at least a subset of the digital audio programming, wherein a
6 set of playback devices receive the digital data signal and authorize playback of the first
7 digital audio signal if the license included in the computer data signal matches at least
8 one license stored in the respective playback devices.

1 25. (New) The digital data signal of claim 24 wherein the cardinality is fixed.

1 26. (New) The digital data signal of claim 24 wherein the cardinality is
2 variable.

1 27. (New) The digital data signal of claim 24 wherein the cardinality is
2 unlimited.

1 28. (New) The digital data signal of claim 24 wherein at least one of the first
2 set of playback devices is a hardware playback device.

1 29. (New) The digital data signal of claim 24 wherein at least one of the first
2 set of playback devices is a software player.

1 30. (New) The digital data signal of claim 24 wherein the first digital audio.
2 content further comprises digital video programming.

REMARKS

Applicants respectfully request reconsideration of the present U.S. Patent application. Claims 1-3, 7, 8, 10-13, 17, 18 and 20-23 have been amended. Claims 9 and 19 has been canceled without prejudice. Claims 24-30 have been added. Thus, claims 1-8, 10-18 and 20-30 are pending.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 7, 8, 11, 12 and 21 were rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 5,757,907 issued to Cooper, et al. (*Cooper*). For at least the reasons set forth below, Applicants submit that claims 1, 7, 8, 11, 12 and 21 are not anticipated by *Cooper*. Claims 1 and 11 have been amended to include limitations from claims 10 and 20, respectively. Claim 21 has been amended to include similar

limitations. Therefore, Applicants submit that claims 1, 11 and 21 are allowable for at least the reasons that claims 10 and 20 are allowable.

Claims 7 and 8 depend from claim 1. Claim 12 depends from claim 11. Because dependent claims include the limitations of the claims from which they depend, Applicants submit that claims 7, 8 and 12 are allowable for at least the reasons set forth above with respect to claims 1 and 11.

Claim Rejections - 35 U.S.C. § 103

Claims 2, 4, 6, 14, 16-18 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cooper* in view of U.S. Patent No. 5,745,879 issued to Wyman (*Wyman*). For at least the reasons set forth below, Applicants submit that claims 2, 4, 6, 14, 16-18 and 22 are not rendered obvious by *Cooper* and *Wyman*.

Claims 2, 4, and 6 depend from claim 1. Claims 14 and 16-18 depend from claim 11. Claim 22 depends from claim 20. *Wyman* is cited to teach storage of licenses in multiple content. See October 14, 1999 Office Action at page 3, comment 13. However, whether or not *Wyman* teaches or suggests storage of licenses as described, *Wyman* does not cure the deficiencies of *Cooper*. Therefore, no combination of *Cooper* and *Wyman* teaches or suggests claims 2, 4, 6, 14, 16-18 and 22.

Claims 9 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cooper* in view of U.S. Patent No. 5,940,504 issued to Griswold (*Griswold*). Claims 9 and 19 have been canceled without prejudice. Therefore, the rejection of claims 9 and 19 under 35 U.S.C. § 103(a) is moot.

Allowable Subject Matter

Claims 3, 5, 10, 13, 15, 20 and 23 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including the limitations of the base claim and any intervening claims.

Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, claims 1-8, 10-18 and 20-30 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date: JAN. 14, 2000

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